

PATENT APPLICATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Francois MALLET et al.

Group Art Unit: 1634

Application No.: 09/680,946

Examiner: J. Fredman

Filed: October 6, 2000

Docket No.: 028662.96

For: RNA AMPLIFICATION METHOD REQUIRING ONLY ONE  
MANIPULATION STEP

REQUEST FOR CORRECTED ACKNOWLEDGMENT OF  
CONSIDERATION OF DISCLOSED INFORMATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

An Information Disclosure Statement with Form PTO-1449 was filed in the above-captioned patent application on October 6, 2000. Applicants have received back from the Examiner a copy of the Form PTO-1449 initialed to acknowledge the fact that the Examiner has considered the cited disclosed information.

In preparing the Form PTO-1449, the cited disclosed information was listed as it was listed on the cover page of U.S. Patent No. 5,817,465 (hereinafter "the 465 patent"), the present application being a reissue of the 465 patent. However, it has subsequently come to Applicants' attention that the Patent Office created several errors on the cover page of the 465 patent, specifically in the "References Cited" section. Thus, since the Form PTO-1449 was created based on the cover page of the 465 patent, several of the references were incorrectly listed on the Form PTO-1449 filed October 6, 2000, and therefore do not correspond to the references that the Patent Office has in its files. See, in particular, U.S. Patent No. 5,229,297, which was incorrectly referred to on the cover of the 465 patent and in the Form PTO-1449 filed October 6, 2000 as U.S. Patent No. 5,229,287, and WIPO Publication No. 91/09944, which was incorrectly referred to on the cover of the 465 patent and in the Form PTO-1449 filed October 6, 2000 as WIPO Publication No. 91/04944.

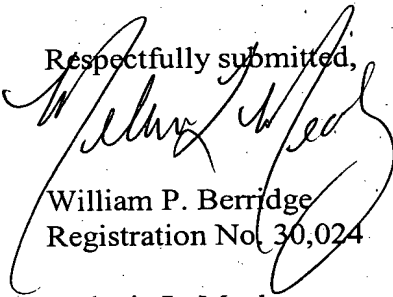
In order to ensure that the references are correctly listed on any reissue patent that issues in the above-captioned patent application, a corrected Form PTO-1449 is attached.

The attached Form PTO-1449 corresponds to the Form PTO-1449 filed October 6, 2000, except that the references have been numbered and corrections have been made to references 4, 11, 13, 15, 16, 18, 19 and 23. It is respectfully requested that the Examiner initial the attached Form PTO-1449 and return a signed copy thereof to the undersigned.

A bona fide attempt to disclose these references was timely made on October 6, 2000. Thus, particularly in view of the Patent Office errors and the fact that the Patent Office files contained the correct references, and the fact that the Patent Office has acknowledged consideration of the references, correct copies of which were in its files, it is respectfully submitted that no fee is required for acknowledgement of consideration of the references correctly identified herein. However, please debit Deposit Account No. 15-0461 as needed in order to ensure that these references are considered.

Should there be any questions concerning this communication, please telephone the undersigned at the number set forth below.

Respectfully submitted,

  
William P. Berridge  
Registration No. 30,024

Melanie L. Mealy  
Registration No. 40,085

WPB:MLM/jam

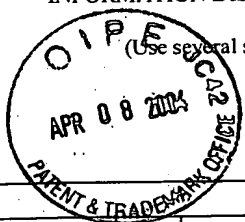
Date: January 13, 2004

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

<p><b>DEPOSIT ACCOUNT USE AUTHORIZATION</b> Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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Form PTO-1449 (REV. 8-83)		US Dept. of Commerce PATENT & TRADEMARK OFFICE		ATTY DOCKET NO. 028662.96		APPLICATION NO. 09/680,946	
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary) <div style="border: 1px solid black; border-radius: 50%; width: 100px; height: 100px; display: flex; align-items: center; justify-content: center; margin: 10px auto;">             O I P E              APR 08 2004              PATENT &amp; TRADEMARK OFFICE           </div>				APPLICANT(S) Francois MALLET et al.			
				FILING DATE October 6, 2000			
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	
	1	4,683,195	7/1987	Mullis et al.			
	2	4,683,202	7/1987	Mullis			
	3	5,021,335	6/1991	Tecott et al.			
	4	5,229,297	7/1993	Schnipelsky et al.			
	5	5,654,143	8/1997	Mallet et al.			
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	
	6	0397463	11/1990	EPO			
	7	0479158	4/1992	EPO			
	8	2669347	5/1992	France			
	9	8601827	3/1986	WIPO			
	10	9102817	7/1991	WIPO			
	11	9109944	7/1991	WIPO			
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)							
	12	W.T. Tse et al., "Reverse Transcription and Direct Amplification of Cellular RNA Transcripts by Taq Polymerase", <i>Gene</i> , vol. 88, No 2, Apr. 16, 1990, pp; 293-296.					
	13	E. Shimomaye et al., "Use of Avian Myeloblastosis Virus Reverse Transcriptase at High Temperature for Sequence Analysis of Highly Structured RNA", <i>Gene Analysis Techniques</i> , vol. 6, No. 2, Mar./Apr. 1989, pp. 25-28.					
	14	Chirgwin, J.M. et al. "Isolation of Biologically Active Ribonucleic Acid from Sources Enriched in Ribonuclease", <i>Biochem.</i> , 18:5294-5299 (1979).					
	15	Glisin, V., et al., "Ribonucleic Acid Isolated by Cesium Chloride Centrifugation", <i>Biochem</i> , 13:2633-2638 (1973).					
	16	Goblet, C., et al., "One-Step Amplification of Transcripts in Total RNA Using the Polymerase Chain Reaction", <i>Nucleic Acids Research</i> , vol. 17, No. 5, (1989) p. 2144.					
	17	Schwartz, S., et al., "Cloning and Functional Analysis of Multiply Spliced mRNA Species of Human Immunodeficiency Virus Type I", <i>Journal of Virology</i> , vol. 64, No. 6, Jun. 1990, pp. 2519-2529.					
	18	Nuovo, G., et al., "Detection of Human Papillomavirus DNA in Formalin-fixed Tissues by <i>In situ</i> Hybridization After Amplification by Polymerase Chain Reaction", <i>Am. J. Pathol.</i> , 139, 847-854 (1991).					
EXAMINER					DATE CONSIDERED		
Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

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		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	
<b>OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)</b>							
	19	Becker-Andre, M. et al., Absolute mRNA Quantification Using the Polymerase Chain Reaction (PCR). A Novel Approach by a PCR Aided Transcript Titration Assay (PATTY), <i>Nucleic Acids Res.</i> , (17):9437-9447 (1989).					
	20	Myers, T.W., et al., "Reverse Transcription and DNA Amplification by a Thermus Thermophilus DNA Polymerase", <i>Biochem</i> , 30:7661-7666 (1991).					
	21	Robert-Guroff, M. et al., "Structure and Expression of <i>tat</i> -, <i>rev</i> -, and <i>nef</i> -Specific Transcripts of Human Immunodeficiency Virus Type I in Infected Lymphocytes and Macrophages", <i>J. Virol.</i> , 64 (7):3391-3398 (1990).					
	22	Guatelli, J.C., et al., "Alternative Splice Acceptor Utilization during Human Immunodeficiency Virus Type 1 Infection of Cultured Cells", <i>J. Virol.</i> , 64(9):4093-4098 (1990).					
	23	Benko, D.M. et al., "A Novel Human Immunodeficiency Virus Type 1 Protein, <i>tev</i> , Shares Sequences with <i>tat</i> , <i>env</i> , and <i>rev</i> Proteins", <i>J. Virol.</i> , 64:2505-2518 (1990).					
	24	Schwartz, S. et al., "Env. and Vpu Proteins of Human Immunodeficiency Virus Type 1 are Produced from Multiple Bicistronic mRNAs", <i>J. Virol.</i> , 64(11):5448-5456 (1990b).					
	25	Holland, S.M. et al. "Immunodeficiency Virus Rev. Protein Recognizes a Target Sequence in rev-responsive Element RNA within the Context of RNA Secondary Structure", <i>J. Virol.</i> , 64(12):5966-5975 (1990b).					
	26	Lawrence, J., et al., <i>Human Retroviruses and Aids</i> , (1990), edited by Myers, G., et al.					
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**PTO RECEIPT FOR FILING OF PAPERS**

► Mail Room (Regular Delivery)

The following papers have been filed:

Amendment Transmittal w/ck #150055 (\$252) Supplemental Amendment; Request for  
Corrected Acknowledgment of Consideration of Disclosed Information

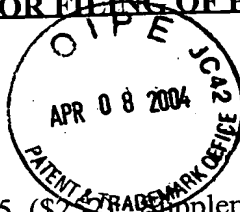
**Name of Applicant:** Francois MALLET et al.

**Serial No.:** 09/680,946

**Atty. File No.:** 028662.96

**Title (New Cases):**

**Sender's Initials:** WPB:MLM/jam



162  
46

**PATENT OFFICE DATE STAMP**



**COPY TO BE STAMPED BY PATENT OFFICE  
AND RETURNED BY MESSENGER**



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For: RNA AMPLIFICATION METHOD REQUIRING ONLY ONE MANIPULATION STEP

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

- ☒ 1. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection, Notice of Allowance, or other action that closes prosecution (e.g., Quayle Action), but before payment of the Issue Fee. Attached is our Check No. 152953 in the amount of \$180.00 in payment of the fee under 37 CFR §1.17(p). Please credit or debit Deposit Account No. 15-0461 as needed to ensure consideration of the disclosed information. Two duplicate copies of this paper are attached.

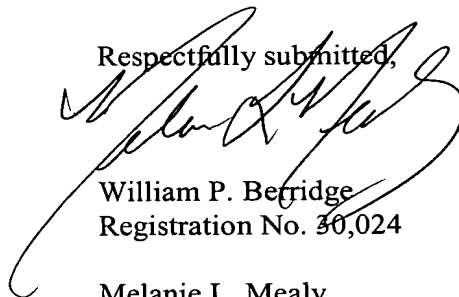
04/09/2004 KBETENAI 00000056 09680946

01 FC:1806

180.00 DP

- ☒ a. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.  
37 CFR §1.97(e)(2).

Respectfully submitted,

  
William P. Berridge  
Registration No. 30,024

Melanie L. Mealy  
Registration No. 40,085

WPB:MLM/jam

Date: April 8, 2004

**OLIFF & BERRIDGE, PLC**  
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**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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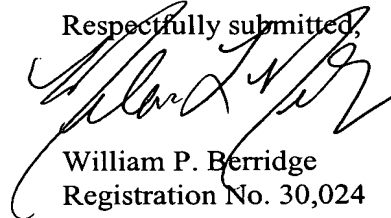
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- ☒ a. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).

Respectfully submitted,



William P. Berridge  
Registration No. 30,024

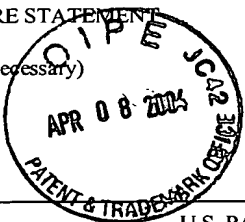
Melanie L. Mealy  
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		A. L. Shaffer, et al., "Amplification, Detection, and Automated Sequencing of Gibbon Interleukin-2 mRNA by <i>Thermus aquaticus</i> DNA Polymerase Reverse Transcription and Polymerase Chain Reaction", Analytical Biochemistry Vol. 190, pp. 292-296 (1990).					
		Michelle F. Gaudette and William R. Crain, "A simple method for quantifying specific mRNAs in small numbers of early mouse embryos", Nucleic Acids Research, Vol. 19, No. 8, pp. 1879-1884 (1991).					
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